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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,462	07/20/2001	Karim Maskatiya	021110-000200US	1742
20350	7590	03/15/2006		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER OYEBISI, OJO O	
			ART UNIT 3628	PAPER NUMBER

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/910,462		MASKATIYA ET AL.	
	Examiner		Art Unit	
	OJO O. OYEBISI		3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: The mailing address and the residence address are missing. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 1, 5, and 6, the claims cannot be clearly understood due to the open-ended nature of the Markush group. A Markush group must be definite and complete as to its membership. The Markush group in claim 1, 5, and 6 is indefinite as to scope in the use of the term "comprising" in the phrase "comprising a credit card number, the information on the magnetic strip of a credit card, a debit card number, the information on the magnetic strip of a debit, a check, a money order, a gift certificate, information on a chip card, devices that store information that may be read by infra red, magnetic waves and/or radio waves, a gift certificate number, a reference number, a tracking number, an authorization number, an electronic signature, a copy of a piece of

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identification of the receiver, and a purchase order". Claim therefore rejected. Examiner suggests that the applicant replace the phrase "comprising" with the phrase "consisting of" to overcome this rejection. Correction is required.

See MPEP § 2173.05 (h).

Re claims 2-4. Claims 2-4 are rejected because of their dependency from the rejected claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brigida et al (Brigida hereinafter, US PAT:5,313,051).

Re claim 1. Brigida discloses the method of delivering at least one item or service from a provider to a receiver the method comprising: providing the at least one item or service to a deliverer; delivering the at least one item or service to the receiver (i.e., delivery route and stops, see col.9, lines 50-67); obtaining at least one piece of data from the receiver at the time of delivery (i.e., signature of the receiving party, see col.5, lines 42-55), the at least one piece of data being from a group comprising a credit card number, the information on the magnetic strip of a credit card, a debit card number, the information on the magnetic strip of a debit, a check, a money order, a gift certificate, information on a chip card, devices that store information that may be read by infra red,

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magnetic waves and/or radio waves, a gift certificate number, a reference number, a tracking number, an authorization number, an electronic signature, a copy of a piece of identification of the receiver, and a purchase order (i.e., parcel identification information, tracking number, bar codes, COD information, information related to where and whom the parcel was delivered, and the electronic captured signature of the receiving party, see col.5, lines 42-55, also see col.9 lines 55-67); providing the at least one piece of data to a financial processor (see col.5, lines 29-40); and providing payment for the at least one item or service from the financial processor to the provider (i.e., COD information, this information can be transmitted in real time to the host system, see col.9, lines 56-67). Brigida does not explicitly, the method comprising: placing an order for at least one item or service to the provider. However, the method of placing an order for at least one item or service to the provider is old and well-known in the art. Thus, it would have been obvious to one of ordinary skill in the art to implement what is well known in the art in light of Brigida to cut delivery cost, and to reduce the time required to update information while delivering goods/services to customers.

Re claim 2. Brigida discloses a method in accordance with claim 1 wherein the at least one piece of data is provided to the provider prior to providing the at least one piece of data to the financial processor(i.e., COD information/ other related information can be transmitted in real time to the host system, see col.9, lines 56-67)

Re claim 3. Brigida further discloses a method in accordance with claim 1 wherein the at least one piece of data is provided to the financial processor substantially

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immediately upon receipt at delivery (i.e., COD information/ other related information can be transmitted in real time to the host system, see col.9, lines 56-67)

Re claim 4. Brigida further discloses a method in accordance with claim 1 wherein the at least one piece of data is provided to the financial processor with other pieces of data from other transactions (i.e., At the completion of a parcel delivery, all of the parcel information normally stored on paper, such as information related to parcel identification, information related to where and to whom the parcel was delivered, and the electronically captured signature of the receiving party, will be stored in storage 104. At the appropriate time, this information can be transferred to an external host system 118 by the host link 110. Those skilled in the art will recognize that the external host 118 can be any one of a number of commonly available processors, such as a mainframe, a minicomputer, a personal computer, or the like. The type and size of the host will be governed by the needs of the particular business using the parcel tracking system 100, see col.5, lines 40-56)

Re claim 5. Brigida further discloses a system for delivering at least one item or service from a provider to a receiver, the system comprising: a provider of at least one of an item or a service; a deliverer; a financial processor; at least one communication channel for providing communication between the provider, the deliverer, the processor and receivers of the at least one of an item or a service; and, a data gathering device for transmitting data obtained by the deliverer during delivery of the at least one of an item or service to at least one of the provider and the processor (see fig.1, see col.5, lines 1-

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67, also see col.9 line 1 through col.10 line 10), the data obtained being at least one of a group comprising a credit card number, the information on the magnetic strip of a credit card, the information on the magnetic strip of a debit card, a debit card number, devices that store information that may be read by infra red, magnetic waves and/or radio waves, a check, a money order, a gift certificate, a gift certificate number, a reference number, a tracking number, an authorization number, address of receiver, a purchase order, an electronic signature and a copy of a piece of identification of a receiver of the at least one of an item or a service (i.e., parcel identification information, tracking number, bar codes, COD information, information related to where and whom the parcel was delivered, and the electronic captured signature of the receiving party, see col.5, lines 42-55, also see col.9 lines 55-67).

Re claim 6. Claim 6 recites similar limitations to claim 1, and thus rejected using the same art and rationale in the rejection of claim 1 above.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HYUNG SOUGH
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